

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are pending: 1-2, 4-10 and 12-34.

The following claims are independent: 1, 33 and 34.

The following claims have previously been cancelled without prejudice or disclaimer: 3 and 11.

Applicant herewith re-presents for entry the amendments made in the After-Final Amendment/Response filed on August 25, 2009, along with additional amendments in this Amendment/Response accompanying RCE, and requests entry of these amendments.

Please amend claims 1, 12-13, 22, 24, 28, 30 and 33-34; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these claim amendments are supported throughout the originally filed specification, figures and claims, and that no new matter has been added by way of these amendments.

Priority

The Examiner asserts on page 4 of the Office Action that Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C.

§119(e). Applicant respectfully traverses this objection, and is currently investigating the priority date of the application, and will respond to the Examiner's objection in due course.

Double Patenting Rejection

Claims 1, 33 and 34 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 32, 33 and 34 of copending Application No. 10/633,080, claims 1, 10, 20 and 21 of copending Application No. 10/456,000, and claims 1, 12, 17 and 21 of copending Application No. 10/464,601. Applicant respectfully traverses the provisional double-patenting rejection and submits that a Terminal Disclaimer may be filed if deemed to be required when the pending applications issue.

Claim Rejections - 35 U.S.C. § 101

Applicant thanks the Examiner for indicating in the Advisory Action that "the 35 U.S.C. 101 rejection will be withdrawn upon entering the after final amendment" (Advisory Action dated August 31, 2009, Continuation Sheet). In view of the Request for Continued Examination filed concurrently with the instant Amendment/Response, Applicant requests entry of the re-presented amendments, and withdrawal of the rejection under 35 U.S.C. §101.

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 1-2, 4-5, 7, 9, 13-14, 18-28 and 30-34 under 35 U.S.C. § 103(a) as being unpatentable over Tengel et al., US Patent No. 5,940,812 (hereinafter "Tengel"), in view of Dave Berns, "Resort Owners Seek Loans", Las Vegas Review Journal, 1999 (hereinafter "Berns"). Claims 6, 8, 10, 12 and 15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Tengel, in view of Berns, and in further view of NJCCC, "Casino Gambling in New Jersey", 1998 (hereinafter "NJCCC"). Claim 16 has been rejected

under 35 U.S.C. §103(a) as being unpatentable over Tengel, in view of Berns, and in further view of “Capitol Briefs”, Arizona Daily Star, 1997 (hereinafter “Briefs”). Claim 17 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Tengel, in view of Berns, and in further view of Credit Risk Management Reporter, “FTC Settles with Debt Collection Agency”, 2000 (hereinafter “FTC”). Claim 29 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Tengel, in view of Berns, and in further view of Official Notice.

Applicant respectfully traverses, and submits that the rejections in the pending Office Action do not establish at least either of requirements (A) and/or (B) of a *prima facie* showing of obviousness, per MPEP § 706.02(j):

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;

(B) the difference or differences in the claim over the applied reference(s);

(C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and

(D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. (MPEP § 706.02(j))

Independent claim 1 recites, *inter alia*:

1. A processor-implemented method for managing risk related to the Gaming Industry, the method comprising:

... receiving into the computer system Gaming Industry related informational artifacts with data associated with reputational risk, legal risk, regulatory risk, and risk related to monetary costs to defend an adverse legal position; (emphasis added)

With regard to these claimed elements, the Examiner alleges:

Tengel teaches ... receiving into the computer system ... (see col 5, line 27 - col. 6, line 45, note that the loan acceptance criteria set by the lender include trade entry, current years in residence, self-employment status, credit limit, CLTV. Note that these refer to characteristics of the borrower) (Office Action, § 13, pp. 8-9)

In contrast to the claimed elements, Applicant submits Tengels discusses a loan acceptance analysis system. Tengels system discusses identifying potential borrowers who may be eligible to receive a loan:

The respective loan acceptance criteria for an offered loan includes a specification of borrower attributes required to be possessed by the borrower to qualify for that loan. (Tengel, col. 5, lines 17-19)

Tengel calculates a “weighted score [a] potential borrower must satisfy” (Tengel, col. 6, line 51) based on the attributes of the borrower. For example, Tengels discusses:

[L]enders may assign weighting factors to any or all of the elements making up the loan acceptance criteria and define an overall weighted score the potential borrower must satisfy... Such weighted multiplied elements may be summed to determine whether the total sum meets the overall weighted score the potential borrower must satisfy. (Tengel, col. 6, lines 48-58)

Tengel discusses that if the potential borrower satisfies the overall weighted score, the borrower is eligible for loans. Tengels loan origination system identifies all loans available to the eligible borrower, and determines a ranking of the best loans for borrower to select from:

The loan attributes of the available loans are analyzed to determine rankings of the best loans. From the rankings of the best loans, the borrower chooses a selected loan provided by a selected lender. (Tengel, Abstract)

Applicant respectfully submits that Tengel's loan acceptance analysis system, receiving attributes of a potential borrower to determine whether the borrower is eligible for a loan, does not discuss or render obvious at least the claimed "receiving into the computer system ... data associated with reputational risk, legal risk, regulatory risk, and risk related to monetary costs to defend an adverse legal position", as recited in amended independent claim 1. Accordingly, Applicants submits that Tengel does not discuss or render obvious at least these recited claimed elements.

Further, Applicant submits Berns, discussing that financially-failing "resort owners seek loans" (see Berns, Title, Abstract), fails to remedy the deficiencies identified above in Tengel with regard to the claimed elements recited in independent claim 1.

Moreover, the Examiner has maintained the improper Official Notice first taken in the Office Action dated September 18, 2008 with regard to claim 29. In the current Office Action, the Examiner states:

Examiner takes Official Notice that it was old and well known in the art at the time of Applicant's invention to have automatically validated and corrected electronic submissions, for example, so that they conform to the standard identifiers used so that correct matches can be found.
(Office Action, p. 29, ¶ 3)

Applicant again traverses this unsubstantiated assertion of obviousness, and again requests the Examiner to provide explicit documentary evidence in support of the assertion. The Examiner argues that Applicant's traversal in the Amendment/Response dated March 18, 2009 is inadequate "since they have failed to argue why the Official Notice statements(s) are not to be considered common knowledge or well known in the art" (Office Action, p. 3, ¶ 1). Applicant respectfully disagrees, and submits that Applicant asserted on page 13 of the

Amendment/Response dated March 18, 2009, that the Examiner has to establish that the asserted element would have been well known to “one of ordinary skill in the art, at the time of the invention” within the context of the recited claim elements (see Amendment/Response dated March 18, 2009, p. 13, line 6). As such, Applicants submit that the Examiner has employed impermissible hindsight by merely concluding that the claimed element(s) allegedly “was old and well known”.

Further, Applicant respectfully submits the Examiner has not defined the level of ordinary skill in the art at the time the invention was made within the context of the claimed invention, much less “cast the mind back to the time the invention was made ..., to occupy the mind of one skilled in the art” [*W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)]. As such, Applicant submits that the claimed element(s) would not be “capable of instant and unquestionable demonstration as being well known” to one of ordinary skill in the art at the time the invention was made within the context of the claimed invention, as per MPEP 2144.03(A) to establish a viable basis for official notice.

Therefore Applicant, again, respectfully traverses the Examiner’s Official Notice (and any other instances of official notice in the Office Action) and requests the Examiner to provide explicit documentary evidence in support of the assertion that the claim element is allegedly unquestionably demonstrable as being old and well known as one of ordinary skill in the art at the time of the invention would understand within the context of the claims, as required by the MPEP.

Although of different scope than independent claim 1, Applicant submits independent claims 33 and 34 are patentable over Tengel and/or Berns, taken alone or in combination, for

at least similar reasons as discussed above identifying deficiencies in the applied references with regard to independent claim 1. Furthermore, Applicant submits that, although of different scope, claims 2, 4-10 and 12-32, which depend directly or indirectly from independent claim 1, are also not discussed or rendered obvious by the applied references, taken alone or in combination, for at least similar reasons as those discussed above identifying deficiencies in the applied references with regard to independent claim 1.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of these grounds of rejections.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-2, 4-10 and 12-34, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art and reserves the opportunity to more particularly traverse, remark and distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to an Office Action objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Office Action objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated

and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

AUTHORIZATION

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-314CP1. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-314CP1.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
CHADBOURNE & PARKE LLP

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By: /Daniel C. Sheridan/
Daniel C. Sheridan
Registration No.: 53,585

Correspondence Address:

CHADBOURNE & PARKE LLP
30 Rockefeller Plaza
New York, NY 10112
212-408-5100 (Telephone)
212-541-5369 (Facsimile)
patents@chadbourne.com (E-mail)